

REMARKS

The Examiner has rejected Claims 35-36 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner has stated that "since claim 1 has the network adapter capable of being installed on the end-point computer, it is unclear how the PCI or ISA will be installed since they are required to be in (i.e. inside attached to the motherboard) the end-user computer."

Applicant respectfully disagrees and emphasizes that Claim 1 requires that the network adapter is "capable of being installed on the end-point computer" (emphasis added), as claimed. Therefore, the language of Claims 35 and 36 is clearly consistent with Claim 1, since, in view of the plain and ordinary meaning of the abovementioned terms of Claim 1, a PCI or ISA card may be installed on the end-point computer.

The Examiner has rejected Claims 1-4, 6-8, 10-21, 23-31, 34, and 38-40 under 35 U.S.C. 103(a) as being unpatentable over Krishnan et al. (U.S. Patent No. 6,075,863), in view of Chi (U.S. Patent No. 6,006,329). Applicant respectfully disagrees with such rejection.

With respect to independent Claim 29, the Examiner has relied on Col. 2, lines 56-65 and Col. 5, lines 16-18 from the Krishnan reference to make a prior art showing of applicant's claimed "processor positioned on a network adapter coupled between an end-point computer and a network, the processor including a packet assembly module, random access memory (RAM), and a scanner module, the network adapter being installed on the end-point computer."

Applicant respectfully disagrees and points out that the above excerpts relied on by the Examiner merely teach that the "[m]odem... also includes [a] controller... RAM... ROM... and modem circuitry" and that the "[c]ontroller... controls the operation of [the] modem circuitry... in accordance with program instructions stored in RAM...

and ROM” (Col. 2, lines 57-60 — emphasis added). Additionally, the excerpts teach that “applets may be used to scan incoming data for potentially hazardous programs” (Col. 5, lines 16-17).

However, merely disclosing that a controller included in a modem controls the modem circuitry and that applets may be used to scan incoming data for hazardous programs, as in Krishnan, fails to teach a “processor including a packet assembly module, random access memory (RAM), and a scanner module, the network adapter being installed on the end-point computer” (emphasis added), as claimed by applicant.

In addition, it appears that the Examiner has relied on an inherency argument regarding the above emphasized claim limitations. Specifically, the Examiner has argued that “it is implied if not inherent that there is a packet assembly module in order to receive data from the outside.” Applicant respectfully disagrees, and asserts that in view of the arguments made hereinabove, any such inherency argument has been adequately rebutted, and a notice of allowance or a specific prior art showing of such claim features, in combination with the remaining claim elements is respectfully requested. (See MPEP 2112)

Further, with respect to the independent claims, the Examiner has relied on Col. 2, line 65-Col. 3, line 12 from the Krishnan reference to make a prior art showing of applicant’s claimed technique “wherein the virus signature files are stored on non-volatile solid state memory on the network adapter” (see this or similar, but not necessarily identical language in the independent claims).

Applicant respectfully notes that the excerpt relied on by the Examiner merely teaches that “RAM... provides storage for applets... [and] may also include battery backed RAM for long term storage of applets and configuration parameters used by the modem software” (Col. 2, line 67-Col. 3, line 2). Additionally, the excerpt discloses that “ROM... includes programming for controlling overall operation of [a] modem... and for executing applets stored in RAM” and that “ROM... includes program code

implementing a virtual machine for execution of programs written in the Java programming language” (Col. 3, lines 3-12).

However, merely disclosing that RAM stores applets and configuration parameters, and that ROM includes programming for controlling a modem and executing applets in RAM, as in Krishnan, fails to teach a technique “wherein the virus signature files are stored on non-volatile solid state memory on the network adapter” (emphasis added), as claimed by applicant.

Additionally, the Examiner has argued that “it would be obvious to also store the virus signature files with the applets and program code in order for the applets executing the virus scan to use the signatures to detect viruses.” Applicant respectfully disagrees and again points out that the above excerpts only teach the storage of applets and configuration parameters in RAM and programming for controlling a modem and executing applets in ROM. Further, on page 3, second paragraph of the Office Action, the Examiner has admitted that “the system disclosed by Krishnan... fails to disclose... that the virus signature files are stored on non-volatile solid state memory on the network adapter.” Thus, the prior fails to teach a technique “wherein the virus signature files are stored on non-volatile solid state memory on the network adapter” (emphasis added), as claimed by applicant.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art references, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above. Nevertheless, despite such paramount deficiencies and in the spirit of expediting the prosecution of the present application, applicant has amended the independent claims to further distinguish applicant's claim language from the above references, as follows:

“wherein the processor is capable of being user-configured;
wherein the processor is capable of determining whether received packets are of interest, passing received packets that are not of interest to the end-point computer, and scanning received packets that are of interest” (see this or similar, but not necessarily identical language in the independent claims).

With respect to the subject matter of former Claim 2 et al. (now at least substantially incorporated into the independent claims), the Examiner has relied on Col. 5, lines 33-35 from the Krishnan reference to make a prior art showing of applicant's claimed technique “wherein the processor is capable of being user-configured.”

Applicant respectfully points out that the excerpt relied on by the Examiner merely teaches that “[t]he use of applets... provides for easy upgrades or updates of modem control software” and that “two modems may negotiate to transfer an applet for the better [communications] protocol” (Col. 5, lines 33-38 – emphasis added). However, merely teaching the upgrading or updating of modem control software, in addition to teaching that two modems may negotiate for a communications protocol, as in Krishnan, fails to teach a technique “wherein the processor is capable of being user-configured” (emphasis added), as claimed by applicant.

With respect to the subject matter of former Claim 8 et al. (now at least substantially incorporated into the independent claims), the Examiner has relied on Col. 5, lines 16-23 from the Krishnan reference to make a prior art showing of applicant's

claimed technique “wherein the processor is capable of determining whether received packets are of interest.”

Applicant respectfully notes that the excerpt relied on by the Examiner merely teaches that “applets may be used to scan incoming data for potentially hazardous programs” and that “[b]y automatically scanning data transferred through [the] modem... the modem may discard the offending transfer or may alert the user to a potential rogue program” (Col. 5, lines 16-23 – emphasis added).

However, automatically scanning incoming data, as in Krishnan, does not teach a technique “wherein the processor is capable of determining whether received packets are of interest” (emphasis added), as claimed by applicant. In fact, automatically scanning incoming data for potentially hazardous programs, as in Krishnan, *teaches away* from “determining whether received packets are of interest” (emphasis added), as claimed by applicant. The Examiner is reminded that the *prima facie* case of obviousness may be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997).

With respect to the subject matter of former Claims 10 et al. and 11 et al. (now at least substantially incorporated into the independent claims), the Examiner has relied on Col. 5, lines 16-23 from the Krishnan reference to make a prior art showing of applicant’s claimed techniques “wherein the processor is capable of passing received packets that are not of interest to the end-point computer” (see Claim 10 et al.) and “wherein the processor is capable of scanning received packets that are of interest” (see Claim 11 et al.).

Applicant again respectfully notes that the above excerpts relied on by the Examiner merely teach that “applets may be used to scan incoming data for potentially hazardous programs” and that “[b]y automatically scanning data transferred through [the] modem... the modem may discard the offending transfer or may alert the user to a potential rogue program” (Col. 5, lines 16-23 – emphasis added). However,

automatically scanning incoming data, as in Krishnan, does not teach a technique “wherein the processor is capable of passing received packets that are not of interest to the end-point computer” (emphasis added), as claimed by applicant. Further, automatically scanning incoming data, as in Krishnan, also fails to teach a technique “wherein the processor is capable of scanning received packets that are of interest” (emphasis added), as claimed by applicant.

Again, applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above.

Applicant further notes that the prior art is also deficient with respect to the dependent claims. For example, with respect to Claim 9 et al., the Examiner has rejected the same under 35 U.S.C. 103(a) as being unpatentable over Krishnan, in view of Chi, and further in view of Makinson et al. (U.S. Patent No. 7,023,861).

With respect to the first element of the *prima facie* case of obviousness and, in particular, the obviousness of combining the Krishnan and Makinson references, the Examiner has argued that it would have been obvious to combine Krishnan with Makinson “in order to relieve the processor from scanning unnecessary packets.” To the contrary, applicant respectfully asserts that it would not have been obvious to combine the teachings of the Krishnan and Makinson references, especially in view of the vast evidence to the contrary.

More specifically, applicant respectfully notes that Krishnan teaches that “applets may be used to scan incoming data for potentially hazardous programs” and that “[b]y automatically scanning data transferred through [the] modem... the modem may discard the offending transfer or may alert the user to a potential rogue program” (Col. 5, lines 16-23 – emphasis added). However, Makinson teaches “identify[ing] the application layer protocol associated with [a] data packet” and that “only certain types of application layer protocol[s]... may be intended for scanning by the associated malware scanner”

(Col. 4, lines 52-56 – emphasis added). Thus, since Makinson teaches that only certain types of protocols may be scanned, whereas Krishnan teaches that incoming data is automatically scanned, Krishnan *teaches away* from Makinson. It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

Applicant respectfully asserts that at least the first element of the *prima facie* case of obviousness have not been met, since it would be *unobvious* to combine the references, as noted above.

Furthermore, with respect to Claim 41, the Examiner has rejected the same under 35 U.S.C. 103(a) as being unpatentable over Krishnan et al. (U.S. Patent No. 6,075,863), in view of Chi (U.S. Patent No. 6,006,329). Specifically, the Examiner has argued that “a person having ordinary skill in the art at the time of the invention would have found it obvious to discard data that may contain harassing content, pornographic content and misinformation in order to keep the incoming data safe for users.”

Applicant respectfully disagrees. In particular, applicant respectfully asserts that Krishnan’s mere disclosure that ‘an applet may provide filtering of “junk e-mail” or other unwanted data’ (Col. 5, lines 24-25), simply fails to even suggest a technique “wherein the unwanted content includes harassing content, pornographic content, junk e-mails, and misinformation” (emphasis added), as claimed by applicant. Clearly, filtering junk e-mail, as in Krishnan, fails to even suggest “harassing content, pornographic content... and misinformation,” as claimed by applicant.

Applicant thus formally requests a specific showing of the subject matter in ALL of the claims in any future action. Note excerpt from MPEP below.

“If the applicant traverses such an [Official Notice] assertion the examiner should cite a reference in support of his or her position.” See MPEP 2144.03.

Again, applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art references, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above.

Thus, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

All of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1351 (Order No. NA11P056/01.187.01).

Respectfully submitted,
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